

REMARKS

Claims 1, 3, 6-14 and 18-22 are pending. Claims 1, 3, 6-14 and 18-22 are rejected.

Claims 1, 8 and 21 are amended. Claims 19 and 22 are canceled. Claim 23 is added.

35 U.S.C. § 112

Claims 19 and 21 are rejected by the Examiner under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Specifically, the Examiner rejects the term “connection” in claim 19 and rejects the phrase “or any other structural material” in claim 21. With respect to the above rejections, Applicant respectfully submits the following remarks.

Claim 19 has been canceled. The subject matter of claim 19 is now presented in new claim 23. Support for new claim 23 is found on page 5, line 25 to page 6, lines 1 to 2, of the instant specification.

Claim 21 has been amended by canceling the term “any other structural material”.

35 U.S.C. §102

Claims 1, 3, 6-9, 11, 13-14 and 20-21 are rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 4,641,474 to Cannarsa.

With respect to the rejection under 35 U.S.C. §102(b), as being anticipated by Cannarsa, this rejection is respectfully traversed for the reasons that follow.

Cannarsa discloses a wallboard fastener that is useful in securing a section or piece of wallboard that is inserted in an opening of the wall or wallboard. The wallboard fastener, as disclosed by Cannarsa, comprises a pair of flat segments or surfaces that are located in a common plane and are joined by a V-shaped section made-up of a pair of legs.

Additionally, the free edges of both flat segments of the wallboard fastener are provided with a row of teeth. Similarly, the legs that make-up the V-section of the fastener are also provided with a row of teeth. During engagement of the fastener into the wallboard, the legs that comprise the V-section of the fastener compress and the teeth, which are located on the legs, are pushed into the wall while the teeth located on the flat surfaces of the fastener engage the side surface of the wall thereby firmly securing the fastener into the wall.

Accordingly, based on Cannarsa's disclosure, the "teeth" of Cannarsa's disclosure (please see Figure 1, # 28 and # 32) are a mandatory component of Cannarsa's disclosure. If the "teeth" of Cannarsa's fastener were not present, the fastener would not be able to be secured to the wallboard. This would render the purpose of the fastener useless. Applicant's invention, as defined by the claims is for a mounting bracket that is used to secure at least one plank to at least one joist to form a deck surface. Also, Applicant has amended claims 1 and 8 as well as their respective dependent claims to include the feature "without teeth", wherein the word "teeth" is meant to have the meaning ascribed to it in Cannarsa's disclosure (please see Column 1, lines 67 to 68 of Cannarsa). Support for the amendment of claims 1 and 8 is found in figures 1 and 2 of the instant application wherein a pictorial representation of Applicant's invention is presented and where it can be clearly seen that the mounting bracket is without teeth.

Applicant's mounting bracket, as represented by the amended claims, has a separating flange, a joist-fastening portion, a support flange, and a plank-fastening flange and wherein the free edge of said planar, plank-fastening flange, is without teeth. Also, the mounting bracket includes at least one joist-fastening hole located in the joist-fastening portion. Similarly, the mounting bracket includes at least one plank-fastening hole located in the plank-fastening flange of the mounting bracket. Further, the support flange of the mounting bracket includes one or more access

holes aligned with each joist-fastening hole to provide access through the support flange to each joist-fastening hole. Applicant's mounting bracket is affixed to the side surface of a joist using a first fastener. The mounting bracket is affixed to the bottom surface of the plank using a second fastener.

Applicant respectfully wishes to point out to the Examiner an important distinction between the disclosure of Cannarsa and Applicant's invention. The distinction resides in the way the fastener of Cannarsa and Applicant's mounting bracket are secured to their respective surfaces. In Cannarsa, the fastener is secured to the surface (wallboard) by a series of teeth. As stated earlier in Applicant's remarks, the "teeth" of the Cannarsa disclosure serves to secure the fastener to the wallboard. Without the teeth of the fastener, which functions by pushing into the wallboard to secure the fastener to the wallboard, the fastener of Cannarsa would be ineffective. In Applicant's mounting bracket, the bracket is secured to the joist by the use of a fastener which is placed in the joist fastening hole located in the joist-fastening portion. Similarly, the bracket is secured to the plank by the use of a fastener that is placed in the plank-fastening hole located in the plank-fastening portion.

In the present Office Action under the section titled "Response to Arguments", the Examiner stated the following regarding Applicant's previous remarks regarding Cannarsa.

"In response to applicant's argument that the reference to Cannarsa is used for fastening a wall board and that the present application is for securing a joint to a deck surface, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim."

Applicant respectfully disagrees with the Examiner's position that the prior art device (Cannarsa's fastener) functions in the same manner as Applicant's invention. If Cannarsa's fastener

were to be placed in the same position as Applicant's mounting bracket (please see Applicant's earlier remarks regarding the position of the mounting bracket in relationship to the joist and plank), the teeth of Cannarsa's fastener would penetrate the top surface of the deck (planks) and surface of the joist. In Applicant's mounting bracket, wherein no "teeth" are present, this type of penetration through to the top surface of the deck, or the surface of the joist, simply can not happen because the mounting bracket abuts the side surface of a joist and also abuts the bottom surface of a plank. The mounting bracket is then secured to the joist and to the plank using a fastener which can be exemplified by, but not limited to, a nail or screw. In Cannarsa's disclosure, the fastener is secured or engaged by the "teeth" of the fastener to penetrate the wallboard.

Under 35 U.S.C. §102, anticipation requires that a single prior art reference discloses each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d. 1241, 1245 (Fed. Cir. 1986). Moreover, anticipation is not shown even if the differences between the claims and the prior art are "insubstantial" and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

Since Cannarsa fails to disclose Applicant's invention as defined in the amended claims, the rejection thereto has been overcome and should be withdrawn.

Claim 22 is rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 4,965,980 to Leavens.

In view of Applicant's cancellation of claim 22, this rejection is now moot.

35 U.S.C. §103

Claims 10, 12, 18 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 4,641,474 to Cannarsa as applied to claim 8 above, and in view of United States Patent No. 5,775,048 to Orchard.

With respect to the rejection under 35 U.S.C. §103(a) of claims 10, 12, 18 and 19 as being unpatentable over U.S. Patent No. 4,641,479 to Cannarsa in view of U.S. Patent No. 5,775,048 to Orchard, Applicant respectfully submits that claims 1 and 8, as amended, distinctly define the present invention from any of the art of record taken singly or in combination for the reasons that follow.

More specifically, independent claims 1 and 8 (claims 10, 12, 18 and 19 depend from claim 8) were amended to define that certain portions of Applicant's mounting bracket assembly are without teeth. Nothing in the art of record teaches or suggests this feature of Applicant's amended claims. In fact, as Applicant stated earlier in this response, the series of teeth which are found on Cannarsa's invention, are a mandatory component of said invention. Since Cannarsa does not teach or suggest Applicant's invention as defined by the amended claims, this disclosure of Orchard has no bearing on the patentability of Applicant's invention.

In considering obviousness, the critical inquiry is whether something in the art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1989). However, neither Cannarsa nor Orchard suggests the desirability of the combination that would yield Applicant's invention.

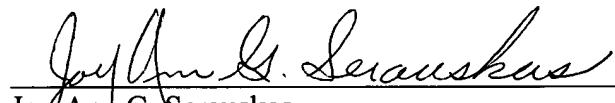
Since the Patent Office has failed to establish a *prima facie* case of obviousness in combining Cannarsa with Orchard, the rejection of the claims under 35 U.S.C. §103 is improper and should be withdrawn. Notice to that effect is requested.

CONCLUSION

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Examiner to telephone Applicant's agent so that the same may be resolved and the application expedited to issue. Applicant requests the Examiner to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

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